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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,414	04/03/2001	Alan Collmer	19603/3243 (CRF D-2601C)	2043
7590	03/03/2004		EXAMINER WAX, ROBERT A	
Michael L. Goldman NIXON PEABODY LLP Clinton Square P.O. Box 31051 Rochester, NY 14603			ART UNIT 1653	PAPER NUMBER
DATE MAILED: 03/03/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/825,414	COLLMER ET AL.	
	Examiner	Art Unit	
	Robert A. Wax	1653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 38-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 38-45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>02192004</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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SUPPLEMENTAL OFFICE ACTION

DETAILED ACTION

Election/Restrictions

1. During the interview with applicants' attorney Examiner realized that Alfano et al. could not qualify as prior art under 35 USC 102(b) but only under 35 USC 102(a) at best. The declaration under 37 CFR 1.131 provides evidence that Alfano et al. was not "by another" as required by 35 USC 102(a). Therefore, that rejection should not have been made. This supplemental Office action explicitly withdraws that rejection and restarts the time period for response. Any inconvenience is regretted.

2. Upon reconsideration of applicants' arguments regarding the similarity of SEQ ID No. 7 and SEQ ID No. 66, the restriction requirement between them is hereby withdrawn. This Office action reflects the findings of a search of SEQ ID No. 66.

Upon reconsideration of the previous rejections, they are hereby withdrawn in favor of the new rejection below.

Information Disclosure Statement

3. The information disclosure statement filed November 3, 2003 has been considered. Please see the attached initialed PTO-1449.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 7-9 and 38-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Charkowski et al. (Ref. 2 on the 1449 filed February 4, 2002).

Charkowski et al. teach an isolated protein having the amino acid sequence of SEQ ID No: 7. This anticipates claims 7, 8, 39, 40 and 44 with no further explanation required. Claim 9 is anticipated because the protein does not exist in a vacuum, but rather, in solution. The water is the carrier. Claim 38 is anticipated because a protein is a protein whether it is produced recombinantly or not, that is, patentability of a product is independent of the process by which it is made. Claims 41-43 and 45 are anticipated because the DNA encoding SEQ ID No. 7 must have a complement that hybridizes under the specified conditions to SEQ ID No. 6.

The Charkowski et al. reference came up in the sequence search for SEQ ID No. 66, it shows that SEQ ID No. 66 is 77.7% identical to SEQ ID No. 7. DNA having SEQ ID NO. 65 would be expected to hybridize to DNA encoding SEQ ID No. 7 under the hybridization conditions specified in claims 7, 41, 42 and 45. Thus, this teaching anticipates claims 7, 9, 38-42 and 45 for the same reasons as above.

One of ordinary skill would not, however, expect that DNA having SEQ ID NO. 65 would hybridize to DNA encoding SEQ ID No. 7 under the hybridization conditions specified in claim 43; in fact, no such DNA was discovered during the sequence search.

Conclusion

6. No claim is allowed.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Wax whose telephone number is (571) 272-0623. The examiner can normally be reached on Monday through Friday, from 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher S. F. Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'Robert A. Wax', is positioned above the printed name and title.

Robert A. Wax
Primary Examiner
Art Unit 1653